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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,125	04/29/2002	Norman Bitterlich	F-7241	5539

28107 7590 11/17/2004  
JORDAN AND HAMBURG LLP  
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NEW YORK, NY 10168

EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

**Application No.**

10/009,125

**Applicant(s)**

BITTERLICH, NORMAN

**Examiner**

Ardin Marschel

**Art Unit**

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                 |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>(2 sheets)</u> . | 6) <input type="checkbox"/> Other: _____                                                |

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### **DETAILED ACTION**

#### **SPECIE ELECTION:**

Applicant's election of Specie C, filed 8/12/04, is acknowledged. Additionally, applicant's traversal argument regarding Unity of Invention practice has been found persuasive and the specie election requirement is hereby withdrawn. That is, all species/embodiments of instant claims 1-5 are hereby under examination.

#### **ABSTRACT**

The abstract of the disclosure is objected to because it exceeds 150 words in length. A new abstract of 150 words or less on its own separate sheet of paper is required. Correction is required. See MPEP § 608.01(b).

#### **NEW MATTER**

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

NEW MATTER has been added to claim 1 via the amendment to part f) which has broadened the outputting in the last line of part f) to no longer require this outputting "as text component". The outputting now set forth in said part f) is generic and no longer limited to a text component outputting. This broadening of outputting for this part f) practice has not been found as filed and is therefore NEW MATTER. Claims which depend from claim 1 also contain this NEW MATTER due to their dependence.

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Another NEW MATTER limitation has been added to claim 1 via the amendment to part h) directed to specifying a "goodness of fit" determination therein. It is noted that part h) previously indicated statistical analysis but not any evaluation therefrom such as a "goodness of fit". This "goodness of fit" limitation for this part h) practice has not been found as filed and is therefore NEW MATTER. Claims which depend from claim 1 also contain this NEW MATTER due to their dependence.

### **VAGUENESS AND INDEFINITENESS**

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the formulation in the claims, the parameter "K" is not defined as to its value or meaning regarding what determines the "k" values correspond to. For example, in claim 1, part b), small letter "k" varies from 1 to "K" but there is no indication as to what the various "k" values nor what the maximum value of "k", which is "K", indicates.

Clarification via clearer claim wording is requested. Claims which depend from claim 1 also contain this unclarity due to their dependence from claim 1.

Claim 1, lines 3-7, requires the storing of reference values as a function of time. In lines 8-9 of claim 1 the measuring of bone marker values is set forth but without requiring any function of time measuring practice. These measured values in lines 8-9 are then recorded and processed as described in lines 10 through the end of claim 1 with a number of time point defined formulae such as in parts b) – e) with a predicted value being derived in part g). Since these cited parts b) – g) include this time point

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processing, the lack of time functional measurement values in lines 8-9 of claim 1 causes the practice of said lines 8-9 to be vague and indefinite as apparently not corresponding to the parts b) – g) processing. It may be assumed that the lines 8-9 measuring is performed as a function of time points, but such an assumption conflicts with the requirements of 35 U.S.C. § 112, second paragraph, which requires clear and concise claim wording as to the practice of a claimed invention. Clarification via clearer claim wording is requested. Claims which depend from claim 1 also contain this unclarity due to their dependence from claim 1.

In claim 1, part a), last line, the performance “after process step x” is cited which lacks clear antecedent basis as to what is meant regarding such a process step within some apparently multi-step process which has not been previously set forth in the claim. Clarification via clearer claim wording is requested. Claims which depend from claim 1 also contain this unclarity due to their dependence from claim 1.

In claim 1, part b), line 2, a “table of values” is cited which lacks clear antecedent basis as to what is meant regarding such a table which has not been previously set forth in the claim. It is noted that the normalization equation in part b) normalizes measured values with respect to a first line of such a table, but that such a table has not been prepared previously in the claim. Clarification via clearer claim wording is requested. Claims which depend from claim 1 also contain this unclarity due to their dependence from claim 1.

In claim 1, part b), last 2 lines, the practice of converting normalized values into time values is set forth but without any indication of what formulation is meant by which

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to accomplish this. It is noted that the normalized values represented by  $M^*$  values in the equation are unitless as expressed by a ratio of  $M$  values in the equation. What practice is meant by the last 2 lines of said part b) to result in time values in months generated from a unitless normalized  $M^*$  set of values? Another related unclarity is that such time values in months are not utilized anywhere else in the claim. Clarification via clearer claim wording is requested. Claims which depend from claim 1 also contain this unclarity due to their dependence from claim 1.

In claim 1, part c), the equation includes an undefined set for values set forth as  $W_k$  values. A review of the specification has not revealed a definition of what is meant by  $W_k$ . Therefore a lack of definition of what determines the values of  $W_k$  causes the claim to be vague and indefinite. Clarification via clearer claim wording is requested. Claims which depend from claim 1 also contain this unclarity due to their dependence from claim 1.

In claim 1, part e), an equation is set forth for calculating a first similarity dimension. In the last 3 lines of said part e) a second similarity dimension is indicated as being simultaneously calculated but there is no indication as to whether the equation utilized for the first similarity dimension is utilized or some other equation. Thus, claim 1 is vague and indefinite regarding the metes and bounds of the second similarity dimension calculation practice in said part e). This has not been clarified via a review of the specification. Clarification via clearer claim wording is requested. Claims which depend from claim 1 also contain this unclarity due to their dependence from claim 1.

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In claim 1, part g), the equation includes an undefined set for values set forth as  $R_j(t)$  values. A review of the specification has not revealed a definition of what is meant by said  $R_j(t)$  values. Therefore a lack of definition of what determines the values of  $R_j(t)$  causes the claim to be vague and indefinite. Evaluation of these values is required in order to calculate the  $R(t)$  values. Clarification via clearer claim wording is requested. Claims which depend from claim 1 also contain this unclarity due to their dependence from claim 1.

In claim 1, part h), last 2 lines, the "actual experience" values lack clear antecedent basis as to which values are meant thereby. The claim lacks citation of "actual experience" values previously in claim steps. Clarification via clearer claim wording is requested. Claims which depend from claim 1 also contain this unclarity due to their dependence from claim 1.

In claim 4, lines 2-3, the description of "empirical values" conflicts with being cited as being "from hypothetical, assumed processes. The normal and customary meaning of empirical values are those which are obtained from experiment or observation and not from hypothetical or assumed situations. This conflict causes the claim to be vague and indefinite as to what is meant thereby.

### INFORMALITIES

The disclosure is objected to because of the following informalities:

In claim 1; parts e), f), and g); the lettering in the subscripting of the equations is too small to be clearly read. Applicant is referred to 37 CFR § 1.58 which requires that

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mathematical formulae must utilize a font or style with capital letters being at least 0.21 cm (0.08 inch) high.

Appropriate correction is required.

### **INFORMATION DISCLOSURE STATEMENTS**

Enclosed are two sheets of PTO Form 1449. Two citations thereon are lined through due to being in the German language and thus not readable by the Examiner due to not being in English.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 12, 2004

*Ardin H. Marschel* 11/12/04  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER